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09/977,664

10/15/2001

Robert D. Herpst

3468

26009 7590 12/29/2010
ROGER M. RATHBUN
13 MARGARITA COURT
HILTON HEAD ISLAND, SC 29926

EXAMINER

ALEXANDER, LYLE

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT D. HERPST

Appeal 2009-010280
Application 09/977,664
Technology Center 1700

Before CHUNG K. PAK, CAROL A. SPIEGEL, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1, 2, 10, 11, 15-20, 28, 30, 31, 33, 35-37, and 39-53, all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

The appealed invention relates to a sample holder for use with a spectroscopic analytical instrument, comprising an infrared light transmitting alkali halide crystal sample supporting substrate, as well as methods of making and using the sample holder. Claim 1 is illustrative:

1. A sample holder for use with an infrared spectrophotometer or infrared filterometer that analyzes a sample through which infrared light is transmitted comprising a mounting means comprised of a first material having an aperture formed therein, an infrared light transmitting alkali halide crystal sample supporting substrate being present in the aperture comprised of a second material allowing infrared light to pass therethrough without the infrared light transmitting alkali halide crystal sample supporting substrate or any other material within the aperture substantially absorbing infrared light within a substantial portion of the infrared spectral range, said infrared light transmitting alkali halide crystal sample supporting substrate being formed by one or more of the steps comprising cleaving, fly cutting, chipping, milling, or scaling.

In addition to the admitted prior art on pages 3-8 of the original Specification ("APA"), the Examiner also relies on the following prior art in rejecting the claims on appeal:

Eden et al.	4,843,030	Jun. 27, 1989
Marker et al.	4,855,110	Aug. 8, 1989
Izumi	4,932,780	Jun. 12, 1990
Gagnon et al.	5,764,355	Jun. 9, 1998

Appellant requests review of the following rejections:

Claims 1, 2, 10, 11, 15-20, 28, 30, 31, 33, 35-37, 39-44, and 46-53 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Gagnon and Eden, further in view of APA or Izumi.

Claim 45 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Gagnon and Eden, further in view of APA or Izumi, further in view of Marker.

OPINION

The issue presented for review is the following:

Did the Examiner err in determining that the combination of Gagnon, Eden, APA, and Izumi would have suggested a sample holder for use with a spectroscopic analytical instrument, comprising an infrared light transmitting alkali halide crystal sample supporting substrate as required by the independent claims.^{2, 3} We answer this question in the affirmative.

Appellant argues that any combination of Gagnon, Eden, APA, and Izumi would not have suggested the claimed invention. (App. Br. 11-24). Appellant contends that Gagnon discloses two sample supporting embodiments. The first embodiment is a screen material and the second embodiment is a microporous sheet. (Paragraph bridging App. Br. 12-13). Appellant argues that Gagnon discloses glass, quartz, metals, and alloys, as well as polymeric materials, are suitable for utilization only as the first embodiment, i.e., screen material. (App. Br. 13). Appellant

² We select independent claims 1 and 45 as representative of the appealed subject matter. Independent claim 45 can be found at pages 45-45 of the Appeal Brief.

³ The Examiner cited APA for "teach[ing that] the second IR transmitting material may be glass, quartz or polymeric materials" (Ans. 3) and for describing it was known to use highly polished crystals with spectrophotometers and Izumi for describing the polishing of crystals (*id.* at 4).

maintains that there is no suggestion to substitute a cleaved crystal for the screen of Gagnon. Appellant further argues that “the Examiner does not point to any teaching in any prior art which shows that a crystal can be made into a screen....” (App. Br. 12).

We agree with Appellant. The Examiner has not provided a reasonable basis for asserting that the claimed particular cleaved crystal is useful as the screen of Gagnon or that a person of ordinary skill in the art would have had any other convincing reason to substitute the claimed particular cleaved crystal for the screen receiving means of Gagnon. The Examiner has failed to rely upon evidence that establishes a sufficient correlation or equivalency between screen material that does not transmit infrared radiation and a crystal substrate that allows infrared radiation to pass through. “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

For the foregoing reasons the Examiner’s rejections are reversed.

DECISION

The Examiner’s rejections of claims 1, 2, 10, 11, 15-20, 28, 30, 31, 33, 35-37, and 39-53 are reversed.

REVERSED

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